

### **REMARKS**

By the above amendment, the Cross Reference to Related Application has been updated to indicate the patented status of the parent application, which was attempted in the Preliminary Amendment filed August 12, 2003. It is noted, however, upon review of the Preliminary Amendment, the requested amendment was made at page 2, line 4, rather than page 1, line 4 and applicants only became aware of such apparent error as a result of the Examiner's indication in the Office Action that the Cross Reference to Related Application has not been updated. Thus, applicants assume that the amendment intended to be made at page 1, line 4 was, in fact, made at page 2, line 4, as directed in the Preliminary Amendment, and therefore, by the present amendment, applicants have made a proper amendment to page 1, line 4 and have replaced the paragraph at page 2, line 4 with the correct paragraph. Applicants assume that by this amendment, the specification has now been corrected.

Additionally, claims 4 and 6-10 have been amended so as to delete the phrase "on the ground" from "control device on the ground".

As to the rejection of claims 4-10 under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 of prior U.S. Patent No. 6,604,031 B2, this rejection is traversed as being improper, and reconsideration and withdrawal of the rejection are respectfully requested.

The Examiner in pointing out that this rejection is a double patenting rejection which cannot be overcome by filing of a Terminal Disclaimer, refers to the decision of In re Vogel, 164 USPQ 619 (CCPA 1970) indicating that the term "same invention," means an invention drawn to identical subject matter. Applicants submit that the Examiner in applying this rejection has misinterpreted the meaning of "same invention". That is, applicants submit that the decision of In re Vogel, supra, requires that the claimed invention of the patent and the claims of the application define

"identical subject matter". As indicated in the aforementioned decision, a good test, and probably only the objective test, for "same invention," is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. Furthermore, the court noted that by "same invention", we mean identical subject matter. Thus, the invention defined by a claim reciting "halogen" is not the same as that defined by a claim reciting "chlorine," because the former is broader than the latter. On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a length of "thirty-six inches" defines the same invention as a claim reciting a length "3 feet," if all other limitations are identical. Applicants submit that claims 4-10 of this application, as previously presented and as amended, do not define the "same invention" in terms of 35 U.S.C. 101, such that the double patenting rejection should be overcome. Applicants note that should the Examiner present a new rejection based on the judicially created doctrine of obviousness-type double patenting, as is also discussed in the decision of In re Vogel, supra, applicants are prepared to submit a Terminal Disclaimer which would overcome such rejection.

Turning first to claim 10 which has been amended to delete the phrase "on the ground" and stands rejected with respect to claims 1-8 of U.S. Patent No. 6,604,031, the parent application of the present application, applicants note that claim 10 is a method claim. On the other hand, each of claims 1-8 of U.S. Patent No. 6,604,031, is an apparatus or system claim and applicants submit that method and apparatus claims are directed to different classes of invention which are recognized as distinct from one another and not "identical subject matter" or "same invention". Thus, applicants submit that at least claim 10, which is a method claim, is not properly rejectable under 35 U.S.C. 101 over the apparatus or system claims 1-8 of U.S. Patent No. 6,604,031, and the rejection with respect to claim 10 of this application should now be overcome.

As to the rejection with respect to claims 4-9, which recite a train detection system, and therefore may be considered to be directed to the same class of invention as the train detection system claims 1-8 of U.S. Patent No. 6,604,031, applicants submit that a basic distinction of the claims of the patent with respect to the claims of this application is that each of claims 1-8 of the patent recite a "wayside controller". Applicants note that the term "wayside" is defined in Webster's New World Dictionary, Third College Edition, as "n. the edge of a road; area close to the side of the road - adj. on, near, or along the side of a road", with it being recognized that the term "wayside" in "wayside controller" may be considered to be utilized as an adjective modifying "controller". As previously recited in each of independent system claims 4 and 9 of this application, the train detection system comprise "a control device on the ground". Applicants submit that "wayside" defines a physical location of the controller which locate is on, near, or along the side of a road, or in this case, the track along which the train travels. In contradistinction, a "control device on the ground" is not limited to a location which is on, near, or along the side of a road or track along which the train travels. Thus, applicants submit that in this feature alone, and utilizing the test referred to in the decision of In re Vogel, supra, assuming arguendo that other claimed features of claims 4-9 of this application may be considered identical to that of the claimed features of claims 1-8 of U.S. Patent No. 6,604,031, which is not the case herein, as will be discussed below, it is readily apparent that the claims of this application could be literally infringed without literally infringing claims of the patent. Furthermore, by the present amendment, the limitation in claims 4-9 of the application of "on the ground" has been deleted so as to provide an even broader limitation with respect to a "wayside controller". Accordingly, at least for this basic distinction, applicants submit that claims 4-9 of this application do not claim the "same invention" as claims 1-8 of the patent, it being recognized that method claim 10 does not claim the "same invention" of claims 1-8 of

the patent. Thus, applicants submit that the rejection based upon 35 U.S.C. 101 should now be overcome.

Applicants further note that independent claim 4 recites the feature that the control device is to be connected to said transmitter and said receiver through a data transmission path which feature is not recited in claims 1-8 of the patent.

Additionally, the control device "collates whether the first unique code data and the second unique code data received from said receiver coincide with predetermined data contents", whereas claims 1-8 of the patent utilize language other than "collates" with many of the claims reciting the feature of "unique code checking means". Further, as to the features of dependent claims 5-8 which depend directly from claim 4, each of these dependent claims recite features not recited in claims 1-8 of the patent and therefore, recite claimed features in which claims of the patent could be literally infringed without the claimed features of claims 5-8 being literally infringed in addition to the features of claim 4. As to independent claim 9, such claim recites the feature in addition to a data transmission path as recited in claim 4 that the transmitter applies a "logical operation with a first unique code data" and that the receiver "applies a logical operation with a second unique code data", and that the control device "collates". It is apparent that claims 1-8 of the patent do not recite a "logical operation". Hereagain, applicants submit that the test for "same invention" in accordance with the decision of In re Vogel, supra, with respect to the features of claim 9 and that of claims 1-8 of the patent results in the "same invention" not being claimed. Thus, applicants submit that the rejection under 35 U.S.C. 101 should now be overcome.

In view of the above amendments and remarks, applicants submit that system claims 4-9, as amended, and claim 10 which is directed to a method, claim an invention which is not the "same invention" as claimed in claims 1-8 of U.S. Patent No. 6,604,031, such that the rejection of claims 4-10 under 35 U.S.C. 101 should

now be overcome. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (503.36233CC4) and please credit any excess fees to such deposit account.

Respectfully submitted,



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